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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,710	03/23/2004	Teng-Kuci Yang	14311 B	5637

36672 7590 12/20/2006
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EXAMINER

SHAMEEM, GOLAM M

ART UNIT	PAPER NUMBER
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1626

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/807,710

Applicant(s)

YANG ET AL.

Examiner

Golam M. M. Shameem, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

Claims 1-3, 9 and 10 are currently pending in the application.

Receipt is acknowledged of amendment / response filed on October 27, 2006 and that has been entered. Claim 1 has been amended. Claims 4-8 have been canceled. Since the status of claims 11-17 has not been identified examiner assumed that the claims 11-17 were canceled.

Response to Arguments

Applicant's amendments and arguments [to withdrawal of the rejection of claims 1-3 and 9-17 under 35 U.S.C. § 102(b)] have been fully considered and found persuasive with respect to the above rejection and the rejection is hereby withdrawn. The rejection of claims 1-3 and 9-17 under the judicially created doctrine of obviousness-type double patenting over claim 1 of US 6,861,536 has been obviated with Applicant's submission of Terminal Disclaimer and that has been entered and the rejection is hereby withdrawn. However, upon further consideration, the following new ground of rejections are made and therefore, Applicants arguments are rendered moot in view of the present Office action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 9 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims contain the subject matter of a newly introduced proviso such as “wherein R² is not phenyl as R¹ is methyl or phenyl” [claim 1 (currently amended), line 5, page 2] to exclude the prior art compounds. This subject matter is considered new matter since the specification and the originally filed claims excluded this subject matter from the compound as can be seen by original claim 1 and the specification. The amendment changes the scope of the claims to include “R² is not phenyl as R¹ is methyl or phenyl” that were not previously included in the invention. This rejection can be overcome by deleting the new matter from the instant claims and also amend the claims with in the context and scope of the claims (limiting R¹ and R² variables that actually contemplated in the specification) in order to overcome the rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. § 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 9 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Trost *et al* (1982) [PTO 892 of 06/16/2006]. Applicant claims aminothiols and their method of uses (catalyzing an asymmetric addition reaction) thereof.

Determination of the scope and content of the prior art (MPEP §2141.01)

Trost *et al* (1982) teach analogous compounds having similar utilities (such as nucleophilic addition reaction) to those of instantly claimed invention.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the claimed compounds and that of the references herein lies in the selection of different variable substitutions in core of formula I, such as having a hydrogen atom substitution for R⁵ of the instantly claimed compound instead of methyl (Me) for the same position in the prior art [wherein R¹ is alkyl of C1-C9 (such as, n-butyl), R² is alkyl of C1-C9 (such as, n-butyl), R³, R⁴ and N form pyrrolidinyl, STN International, HCAPLUS database, RN 81230-62-8, a copy was provided with previous Office action].

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

It would have been *prima facie* obvious to one having ordinary skill in the art at the time of the invention was made since Trost *et al* teach compounds which are generic to the claimed compounds. It is well established that the substitution of hydrogen for alkyl (such as, methyl) on a known compound is not a patentable modification absent unexpected or unobvious results. *In re Wood*, 199 U.S.P.Q. 137 (C.C.P.A. 1978) and *In re Lohr*, 137 U.S.P.Q. 548, 549 (C.C.P.A. 1963). The disclosure of Trost *et al* that teach substituted aminothiols, compounds, which would easily place Applicants invention in possession of the public at the time of Applicants invention, was filed. Therefore, in the instant case, one skilled in the art would be motivated to choose to replace a methyl group with a hydrogen atom or *vice versa* in view of the known teaching of the art. The claimed compounds are so closely related structurally to the homologous compounds of the reference as to be structurally obvious therefore in the absence of any unobviousness or unexpected properties. Since the core of formula I is not novel and the novelty (if there is any) belongs to the selection of different variable substitutions, a great caution should be exercised to determine the patentability of the claimed invention. Therefore, in looking at the instant claimed

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compounds as a whole, the claimed compounds would have been suggested to one skilled in the art unless unobvious or unexpected results can be shown.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone number for this Group is 571-273-8300.

When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy

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published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG
89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Golam M M Shameem, Ph.D.
Primary Examiner
Art Unit 1626,
Technology Center 1600

A handwritten signature in black ink, appearing to read "G. M. Shameem", with a stylized flourish at the end.

GOLAM M. M. SHAMEEM, PH.D
PRIMARY EXAMINER

December 12, 2006